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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/712,327

11/13/2003

Daniel Craven

P-US-PR-1091

1986

7590

12/01/2006

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EXAMINER

DURAND, PAUL R

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,327

Applicant(s)

CRAVEN ET AL.

Examiner

Paul Durand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/22/06 and interview on 11/21/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9, 12 and 14 is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 13, 15-20, 22, 23 and 25-34 is/are rejected.
- 7) ☒ Claim(s) 6-8, 10, 11, 21, 24 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 20061122.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,4,5,13,15-17,22,23 and 25-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bausch (US 4,588,910) in view of Dibbern (US 4,684,774).

In claim 1, Bausch discloses the invention as claimed including a tool housing, with a handle projecting from a first side of the housing, an electric motor "M", integrated switch unit comprised of motor control unit, which turns the motor on and off (indicated by on/off housing 35), a first manual switch member in the form of trigger 2, located in the handle adjacent to the switch unit and operatively connected to the motor control unit, a second manually operated switch member 9, connected to the motor control unit via actuator (not shown), which drives the motor in a forward and reverse direction, the second switch remotely located from the switching unit and depending on the tool orientation and as shown in figure 3, located on an upward facing surface of the tool housing which can be seen during normal operation of the tool and linkage assembly in the form of crank 25, which operatively connects the second switch to the motor control unit through an actuator in the form of pin 40, which is moved in response to the movement of the second switch member to move the motor in a forward or reverse direction (see Fig. 1-3,6 and C3,L4 – C4,L59). What Bausch does not disclose is the

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second manual switch located on a second side of the housing substantially opposite the first side. However, Dibbern teaches that it is old and well known in the art of power tools to provide a tool with a housing 11, having a handle 16 located on a first side, with a first switch and a second switch 77 located substantially opposite the first side on an upward facing portion of the tool for the purpose of increasing ease of use to the user (see Figs. 2,11,13 and C5,L21-37).

Additionally and in regard to the location of the second switch, to would have been obvious to one having ordinary skill in the art to have modified the invention of Bausch alone by locating the second switch into any desirable position on the tool, since it has been held that rearrangement of working parts on a device involves only routine skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). See also MPEP § 2144.04(VI)(C).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Bausch with the switch arrangement as taught by Dibbern for the purpose of increasing ease of use to the user.

In claim 4, Bausch discloses the invention as claimed including the first manual switch member located on a downward portion of the tool.

In claim 5, Bausch discloses the invention as claimed including linkage 25 pivotally mounted at 40 (see Figs. 3 and 6).

In claim 13, Bausch discloses the invention as claimed including first arm 27, connecting the second switch 9 to the linkage 25 (see Fig. 3).

In claim 15, Bausch discloses the invention as claimed including power member in the form of trigger switch 2 (see Fig.2).

In claim 16, Bausch discloses the invention as claimed including the first switch member and switch unit 35, arranged such that when the first switch member is acted on by a user of the tool so as to power a motor, it holds the actuator (not shown) against movement by the linkage 25 by engaging the linkage at 29 (see Fig. 3,7 and C4,L11-28).

In claim 17, Bausch discloses the invention as claimed including a hand held tool with housing, upper and lower facing portions, downward extending handle, electric motor "M", integrated switch unit, with motor control unit, which turns the motor on and off (indicated by on/off housing 35) and located in the handle area, first manual switch member in the form of trigger 2, operatively connected to the motor control unit and projecting through the handle, second manually operated switch member 9, located remotely (not integral with the switch unit) in a position that allows the user to see the switch during normal operation by it's projected location on the handle, linkage assembly in the form of crank 25, which operatively connects the second switch to the motor control unit through an actuator in the form of pin 40, which is moved in response to the movement of the second switch member to move the motor in a forward or reverse direction (see Fig. 1-3,6 and C3,L4 – C4,L59). What Bausch does not disclose is the position of the switch projecting from the top of the housing and the switch seated on a boss. However, Dibbern teaches that it is old and well known in the art to provide an adjusting member 62, with a switch member 79, projecting from the top of the tool,

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which rotates longitudinally to a tool motor, mounted on a bearing boss 21 and fixing boss 23 which attaches rear cover and limits the movement of the adjusting member 62 for the purpose of operating and reducing the size of a tool (see Figs. 2,11,13 and C5,L21-37).

Additionally and in regard to the location of the second switch, to would have been obvious to one having ordinary skill in the art to have modified the invention of Bausch alone by locating the second switch into any desirable position on the tool, since it has been held that rearrangement of working parts on a device involves only routine skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). See also MPEP § 2144.04(VI)(C).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Bausch with the switch arrangement as taught by Dibbern for the purpose of operating and reducing the size of a tool.

In claims 22 and 23, Bausch discloses the invention as claimed including linkage 25 pivotally mounted at 40 and a first arm 27, connecting the second switch 9 to the linkage 25 (see Figs. 3 and 6).

In claim 25, Bausch discloses the invention as claimed including power member in the form of trigger switch 2 (see Fig.2).

In claim 26, Bausch discloses the invention as claimed including the first switch member and switch unit 35, arranged such that when the first switch member is acted on by a user of the tool so as to power a motor, it holds the actuator (not shown) against

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movement by the linkage 25 by engaging the linkage at 29 (see Fig. 3,7 and C4,L11-28).

In claim 27, Bausch discloses the invention as claimed including a hand held tool with housing, electric motor "M", located within the housing, a handle projecting from a first side of the housing, integrated switch unit, with motor control unit, first manual switch member 2, located in the handle and selectively positionable for controlling power to the motor, second manually operated switch member 9, located and projecting through a side of the housing and selectably positionable for controlling the direction of the tool and linkage assembly in the form of crank 25, which operatively connects the second switch to the motor control unit through an actuator in the form of pin 40, which is moved in response to the movement of the second switch member to move the motor in a forward or reverse direction (see Fig. 1-3,6 and C3,L4 – C4,L59). What Bausch does not disclose is the second switch projecting from a second side of the housing substantially opposite to the first side of the housing. However, Dibbern teaches that it is old and well known in the art of power tools to provide a tool with a housing 11, having a handle 16 located on a first side, with a first switch and a second switch 77 located substantially opposite the first side on an upward facing portion of the tool for the purpose of increasing ease of use to the user (see Figs. 2,11,13 and C5,L21-37).

Additionally and in regard to the location of the second switch, it would have been obvious to one having ordinary skill in the art to have modified the invention of Bausch alone by locating the second switch into any desirable position on the tool, since it has been held that rearrangement of working parts on a device involves only

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routine skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). See also MPEP § 2144.04(VI)(C).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Bausch with the switch arrangement as taught by Dibbern for the purpose of increasing ease of use to the user.

In claims 28 and 29, Bausch discloses the invention as claimed including the integrated switch located in the handle and adjacent to the first switch member (see Fig. 2).

In claims 30 and 31, Bausch discloses the invention as claimed including the first manual switch being a variable operated trigger switch.

In claims 32-34, Bausch discloses the invention as claimed including linkage 25, having an annular portion pivotally mounted at 40, inside the housing and a first arm 27, connecting the second switch 9 to the linkage 25 (see Figs. 3 and 6).

3. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bausch in view of Schell et al (US 5,738,177).

In claim 18, the modified invention of Bausch discloses the invention as claimed as applied to claim 17 above except for the housing being formed as a jam pot housing. However, Schell teaches that it is old and well known in the art to provide a housing formed from a jam pot design for the purpose of increasing the ease of manufacture (see Fig.1 and C5,L29-44). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the

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invention of Bausch with the housing as taught by Schell for the purpose of increasing the ease of manufacture.

In claims 19 and 20, the modified invention of Bausch through Dibbern discloses the invention as claimed including bearing boss 21 located on a closed end of the motor housing located at the rear end adjacent to the motor (see Fig.2).

Allowable Subject Matter

4. Claims 9,12 and 14 are allowed.
5. Claims 6-8,10,11,21,24 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

The rejection of claim 17 has been maintained. A new ground of rejection has been issued for independent claim 1, as the claim has been amended in an attempt to overcome the prior art. As stated above, the rejection of Dibbern clearly teaches the use of a second switch member located opposite the handle. Claims 18-35 are new and as a result claims 18-20,22,23 and 25-35 have been rejected.

Upon further consideration, the rejection of claim 6, has been rescinded. Although the rearrangement of parts has generally been held to be routine in the art,

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there would be no suggestion from the prior art to move the linkage assembly to the motor housing portion. See MPEP §2144.04(VI)(C). The rejection of claims 7,8,10 and 11 have been withdrawn as being dependent upon claim 6.

Applicant has amended claim 1 to further define the location of the second manual switch. Additionally claims 17 and 27 attempt to do this also. As a result, the teaching of Dibbern has been provided to show applicant that it would be well known in the art to locate a manual switch on top of the tool. Moreover the examiner asserts that there is sufficient motivation to relocate the switch of Bausch, without the teaching of Dibbern. MPEP §2144.04(VI)(C) states that the "prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

In this instance, Bausch on column 1, lines 50-55, discloses that the location of the second manual switch is for purpose of "inadvertent operation". While inadvertent operation can be caused by many means, the clearest ways are accidental setting and the ability not to see the position of the switch on the tool. Moreover, applicants' specification on page 1, paragraph 0004 discloses that inherent problem to be solved by the switch location is the inadvertent operation of the tool in the wrong direction. The examiner asserts that the reasons for the location of the switch in both Bausch and applicant are similar and as such there would be motivation solely on the basis of Bausch alone to provide the second manual switch opposite the handle.

Therefore, for the reasons indicated above the rejection is deemed proper.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

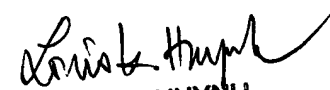
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul Durand
November 22, 2006


LOUIS K. HUYNH
PRIMARY EXAMINER